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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,734	09/29/2000	Jeffery P. Robert	02690.002	2819

27966 7590 09/26/2003

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EXAMINER

FORTUNA, ANA M

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Advisory Action</b>	<b>Application No.</b> 09/675,734	<b>Applicant(s)</b> ROBERT ET AL.	
	<b>Examiner</b> Ana M Fortuna	<b>Art Unit</b> 1723	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-9, 28-34.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Ana M Fortuna  
Primary Examiner  
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***Response to Arguments***

1. Applicant's arguments filed 8/14/03 have been fully considered but they are not persuasive. Applicant argues that "means for producing potato process water in the apparatus of the present invention are not disclosed by Ladha, to which the Examiner agrees. However, the combination of Potter '854 and Potter '652 with Ladha '065 is considered proper. The only teaching that Ladha provides is a system arranged with a combination of ultrafiltration and reverse osmosis, the ultrafiltration arranged as prefilter for the feed effluent to remove larger contaminants previous to the reverse osmosis membrane, and to avoid therefore plugging of the reverse osmosis membrane. Both Potter 's references teach "means for producing potato process water" of potato food processing plant; connected to membranes, RO or UF, to produce water suitable for discharge or reuse in the processing plant. The use of RO or UF membranes depends on final water quality requirements. Arranging the filtration system of '854 by adding a reverse osmosis membrane to further purify the permeate (18), based on the references above, and in particular based on Ladha, it would have been obvious to one skilled in the art at the time the invention was made. Arranging the system of Potter '652 by inserting an UF unit previous to the reverse osmosis membrane (32)(RO), it would have been also obvious to one skilled in the art at the time the invention was made, based on the suggestion of Ladha of using ultrafiltration as pretreatment to a reverse osmosis membrane to avoid clogging of the membrane, this is prevented in the system of '652 by centrifugation of concentrate previous to recycling.

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For these reasons the rejection of the system for treating starch-based wastewater is maintained.

**OBVIOUSNESS DOES NOT REQUIRE ABSOLUTE PREDICTABILITY.**

After considering references by themselves to see whether they suggest doing what appellants have done (In re Skoll, 523 F2d 1392; 187 USPQ 481), the court considers whether a person of ordinary skill in the art combining g the individual steps which for the claimed process (system) would have sufficient bases fro the required expectation of success.

In the present invention the expectation is that by providing an ultrafiltration membrane (UF) previous to the nanofiltration membrane larger flow and better performance of the reverse osmosis membrane can be achieved as is confirmed by Ladha, and can be applied to Potter for the same purpose of removing larger contaminants previous to passing the potato waste stream to the reverse osmosis membrane.

A rejection based upon a combination of references cannot be overcome by attacking the references individually; rather, the combination must be viewed collectively as a teaching to those skilled in the art presumed to be familiar with the references. EX parte Varga, 189 USPQ 204(Bd of Appl. 1973).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana M Fortuna whose telephone number is (703) 308-3857. The examiner can normally be reached on 9:30-6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on (703) 308-0457. The fax phone

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number for the organization where this application or proceeding is assigned is (703)

872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ana M Fortuna  
Primary Examiner  
Art Unit 1723

AMF